REVIEWS
OF
PATENT LAW BOOKS

By

EMERSON STRINGHAM

The pages which follow quote reviews that have been published of books done by Dr Stringham.

Preceding the reviews of each book is a statement of the number of pages of which the book consists, the number of sections into which divided, the number of decisions covered, date of publication, and price. The reviews are quoted *in toto*, adverse comment being included with favorable comment.

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REVIEW FROM
N. Y. UNIVERSITY LAW REVIEW,
Vol XV p 609

In the preface the author states "To the engineer and to the general legal practitioner, as well as to the patent specialist, in government service or in private practice, this book is offered as a desk tool, giving quick verification, with respect to elementary day by day problems. The specialist will find his work cut in half when he wishes to go to the digests for detailed treatment." Mr Stringham makes, so far as this reviewer is concerned, a new departure in the thoroness with which he arrives philosophically at the fundamental principles against which any particular decision must be measured. This method gives a clearer picture of the underlying principles of patent law than the more conventional treatment, if at the same time it makes it a little more difficult to pick up the book to find a concrete answer to a concrete problem. But even if it makes the matter a little more difficult it makes it much more possible to determine that the answer arrived at is correct.

The first section comprising the first 135 pages of the book takes up, philosophically, the meaning of law and of patent law from the standpoint of philosophy. This section is a necessary prelude to the author's system of treatment and if in spots this reviewer had to gasp for breath, that may be laid to his own more limited knowledge of philosophy. It was readable at all points and it amply repays for itself in that it laid the foundation on which the patent law must be based.

The latter part of this first section is a summary treatment, section by section, of the principles of patent law and it should be useful to any general practitioner in understanding what the meaning and purpose of patent law is.

The remaining nine sections of the book take up the law in greater detail and are coordinated with the original summary by an ingenious system of section numbering so that the detailed treatment of the balance of the book is easily coordinated with the initial summary. These sections numbered 1000 to 9000 are as follows. Section 1000—Right to a patent; Section 2000—Loss of right; Section 3000—Inventivlevel; Section 4000—Right from patent; Section 5000—Scope of protection; Section 6000—Patent Office and practice; Section 7000—Opposition, revocation and correction; Section 8000—Enforcement of the monopoly; Section 9000—Ownership, transfer and contract.

From the above headings it will be noted that the important subject of Inventivlevel is separated from the other requisites to a right to a patent. The logical reason for this separation is not clear, but the practical importance of inventivlevel clearly justifies the extensive and separate treatment accorded to it.

The conclusions of the author in this respect are of interest. "Inventivlevel is one of the law's standards, or norms, or values. The subsumption of any given instance must depend upon the exercise of human judgment, hunch, value, criticism, gut reaction. There is no other gage for measuring the level which achieves 'invention'; objective criteria are lacking."

The author does not rest his discussions around court decisions in individual cases. Such decisions, based upon their own individual facts, can not clearly be interpreted without a greater study of the individual facts than can be given in a text book. It follows that they are apt to be cited in cases where the resemblance is superficial only, thus resulting in a false conclusion. This author,

rather, tries to determine the principles underlying the problem and to this reviewer it seems the most illuminating discussion he has read.

The book makes a sharp departure from customary practice in that the text contains no references to court decisions as authorities. To compensate for this he does, however, make extensive reference to Corpus Juris and to various special studies that have been made on special points, thus making them in effect supplements to the work itself and enabling him to carry his study as far as he may desire.

Thus the author seems to determine the principle of patent law on any point, not from single decisions which might point one way or the other but rather from the studied opinion of practitioners based upon the whole body of law upon that subject. In this respect the extensive bibliography is probably a far saner and more careful authority for the proposition of law laid down than individual decisions could possibly be.

To a practitioner trying a case which must by its very nature be tried on a somewhat superficial basis, the book may have limitations as compared with a text frankly based upon court decisions such as Corpus Juris which lists in detail all the decisions for and against any proposition so that the practitioner desiring the case supporting his point of view whether right or wrong, will find them readily available, but to the practitioner engaged in work warranting more profound study, this book appears to be an important contribution on patent law. It is the most thoughtful and most sound treatment on the subject that we have encountered.

WILLIS B. RICE.

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REVIEW FROM
BOSTON UNIVERSITY LAW REVIEW
Vol XVII p 769

Let me here and now record the apparently valid observation (together with a disclaimer as to its originality), that books of law appear to be at once the easiest and the hardest to write—the easiest, because the materials out of which they are fashioned are available to all prospective authors, and the hardest, because a distinctive manner of writing such books is the possession of few authors. Dr Stringham is one of these authors: this is not the first occasion when I have mentioned this fact.[1] Rare are the patent law treatises which inspire positive affection for their style and clarity of expression, in addition to respect for their contents, but this book is one of them. To read it is to be privileged to enjoy an aesthetic treat—the pleasure of watching the graceful play over the whole of a field of law of a keen mind unhampered by prepossessions which may have nought in their favor save that they are casual acquisitions of past years. But that is not to say that Dr. Stringham has no clear cut convictions—on the contrary, his convictions have that definitiveness that only an author who is profoundly versed in his subject can afford to hold. If I may compare him with an author whose writings are remote from patent law literature, I would say that the writer whom he most resembles in spirit is Samuel Butler. Like Butler, he approaches each topic from a fresh point of view, having divested his mind of preconceived notions. Thus, to Dr Stringham, a particular doctrine of law is not

[1] 16 Boston University Law Review 519.

destined to remain current or immutable forever, simply because it has persisted unchanged in the decisions of the past, and the question of its validity may always be raised anew: mental stereotypes form no part of his intellectual machinery. What I marvel at constantly is the vitality which informs his every sentence, and he has never failed to interest me however often I may disagree with his opinions: the occasional demolition of one of my own cherished convictions is a small price to pay for a sound critical reappraisal of the validity of the remainder of them.

What shall be said about this book? A detailed resumé of its contents would be a pedestrian synopsis of the book shorn of its interest-arousing qualities: a recital of its chapter headings would convey an entirely inadequate estimate of its substance. Far better for me to say that Dr Stringham has neatly extracted from the whole of the literature of patent law the essence of the subject and has objectified it in a smoothly flowing narrative intelligible and useful alike to the general practitioner of law, the patent attorney and the engineer. And by the whole of the literature of patent law, I mean the decisions of the courts, the several digests including the section on Patents in Corpus Juris, Title 35 of the U. S. Code Annotated entitled Patents and the Key Number digests, the textbook and pamphlet material, and the law-review articles including especially articles published in the *Journal of the Patent Office Society:* there seems to be in the English language and in foreign languages as well no literature relating to patents of which Dr Stringham is unaware; and in many instances, he has shown commendable eclecticism by including in this work lengthy excerpts from such sources. Then there are several features of this book which, because of their exceptional character, call for special mention. Thus, for example, Dr Stringham does not treat patent law as a subject removed from all other social phenomena—in a vacuum as it were—for in the opening chapter, he prepares the reader for the account of patent law to come by acquainting him with the salient traits of the social order whereof patent law is an instrumentality, and with the philosophical background of law in relation to which the specific subject of patent law is to be displayed. A short essay might be written upon the unique system of classification of subject matter which is employed in this book and in Dr Stringham's earlier works and which is most helpful in locating any desired topic. The extensive bibliography, complete in all details, and the elaborate and exhaustive index are features which are now expected as a matter of course in Dr Stringham's works.

Dr Stringham's writings appear to be the most thought-provocative force in the literature of patent law of the present day, and this book cannot fail to exert a measurable influence upon the future development of patent law. Therefore I nominate it as required reading for the conservative members of the patent bar and recommend it to all of the others.

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REVIEW FROM
TEMPLE UNIVERSITY LAW QUARTERLY
Vol XII p 141

Even without the added weight of this, his most recent contribution to the field, Dr Stringham's position as the most voluminous writer on patent law would be secure. Since 1924, Dr Stringham nas published, either by him-

self, or as co-author, six other books on the subject in addition to a large number of shorter articles. In contrast to his former books, which tended to discuss in detail certain specific branches of the patent law field, the present volume attempts just what its name indicates, namely, a bird's eye view of the entire field in all its aspects. Detail is sacrificed in favor of comprehensiveness. The broad outlines of the picture are blocked in, but for the finer detail and the shading one must look elsewhere. For the convenience of those who desire to make this additional search, Dr Stingham has included throughout his book pertinent references to the standard digests and other publications, and has collected these references in forty-four pages of bibliography.

Of the 691 pages in the book, only about 450 pages can be said to be devoted strictly to an informative discussion of the question at hand. The remaining pages consist of table of contents, an excellent index, a résumé of what the author is going to talk about, and an excursion into the field of philosophy and its application to patent law.

The material contained in the book, which is separated by the author into ten main sections, may be divided roughly into five parts. The first part is an introductory survey containing philosophical and sociological discussion. It also treats of taxation, and the significance, importance, and respective relationships of disclosure to the patentee, the right to a patent, and operativeness.

The second portion discusses substantive patent law. Those factors which affect the right to a patent, such as novelty, prior use, reduction to practice, diligence, prior printed publications and patent applications are presented. Then the author sets forth those factors which govern the loss of a patent right as well as the principles which are used to determine whether or not a given device is patentable. Next he treats of the rights of the patentee, and the limitations of the right to "make, use and vend." Contributory infringement, intent to infringe, experimentation with an importation of protected articles, and rights against governmental bodies are also discussed in this connection.

The third section deals with the procedure in applying for a patent or in attacking the validity of an existing patent, while in the following section the author treats of the remedies for violation of patent rights and the procedure to be followed in obtaining redress.

The final portion of the book deals with the patent as property. Among the topics discussed are contracts involving patent rights, restrictive regulation, equitable title to patents, and assignments.

Anyone familiar with Dr Stringham's other books would expect this one to be "unusual." It is. Several features contained in it, some of them meritorious, others perhaps not, contribute to make it so. As previously indicated, there is interspersed throughout, philosophical, logical and metaphysical discussions which are not ordinarily found in law books, especially patent law books. Some readers will find these discussions entertaining and even instructive; to others they will be merely mysterious and confounding. Other interspersions are occassional brief personal comments by the author upon a variety of subjects; comments that are as entertaining as they are irrelevant. Altho there are frequent brief discussions of adjudicated cases and the decisions therein, the book contains practically no references to cases by name or citation; no footnotes as such. In lieu of such references, the author has inserted at the end of almost every section, and occasionally in the body therein, pertinent citations to the standard digests and to other publications listed in his

extensive bibliography. Whether the practicing lawyer, impatiently searching for his authorities, will welcome having to take the continual side journeys into other legal works which the author's method makes necessary is open to question. Certainly, Dr Stringham could not have compressed into one small volume the amount of information which he has by any other method. Furthermore, his method is a welcome relief in some ways from the bulky legal works, in other fields of law as well as patent law, which conceal their inherent aridity under an extensive undergrowth of footnotes and quotations. Nevertheless, the inclusion of a greater amount of illustrative material and the citation of the more important cases accompanied by a discussion and interpretation of them, would have added considerably to the usefulness of the book without adding measurably to its bulk.

The field of patent law has never been particularly fortunate in its terminology. The author has boldly attempted to improve the situation by introducing a large number of new names. Some of his terms are mystifying (space-time continuum), some are arresting and vivid (gut-reaction), some are happily expressive (inventivlevel). It is probably safe to predict that some of them will find a permanent and useful place in the patent law vocabulary. In the meantime, a glossary would make the book that much more readable.

Despite a few shortcomings indicated above and several innovations, both in approach and in typography, which the admirers of orthodoxy may find irritating, Dr Stringham has made a worthwhile contribution to the literature on patent law. Unlike most of our American writers, he has recognized that many valuable treatises on patent law have been written in languages other than English, and his book is enriched by frequent references to and discussions of them. The greatest merit in his work lies in the acute, discerning, and critical approach which he takes toward the present status of the law. One could read many a modern book on patent law with no intimation that the field is anything but well ordered, well-organized ,and well-reasoned; a field where every case fits neatly into its proper pigeon-hole, and nothing is ever out of place or out of joint. The author leaves us with no such fond illusions. With penetrating gaze he surveys the law and finds it often muddled, often inconsistent. The fact that he exposes these defects in a few words instead of dwelling upon them for pages adds to the effectiveness of his exposure rather that detracts from it. The same may be said for his occasional indulgence in exaggeration.* Any book which stimulates thought, takes one's mental processes out of a rut and fosters a critical and questioning attitude in others, must necessarily be classified as a worth-while contribution. If Dr Stringham's statement that "progress consists in the substitution of bad patent law books for worse ones," (p 5) constitutes, as it probably does not, the author's own evaluation of his latest book, he has been unwarrantedly modest.

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*E. g. "The word 'intent' . . . . generally means what the court thinks the parties would have intended, if they had passed to the stage of having an intent, and at that stage had agreed to that to which the court thinks they ought to have agreed. Otherwise expressed the judge follows his emotional reaction, and rationalizes this reaction under the word 'intent'." § 9440. See also § 5900 and 9080.

REVIEW FROM
JOURNAL OF THE PATENT OFFICE SOCIETY
Vol XIX p 430

This book, by the well known author, Dr Stringham, is pretty well described by its title, except that the author might have added thereto the declaration, "from a philosophical point of view." Dr Stringham has undertaken the very ardent task of crowding into 550 pages of text a complete outline, not only of the substantive law of patents, but of the practice, ex parte and interference in the Patent Office and for litigation in the courts. Necessarily, language has been condensed and the authorities cited are other treatises and digests and not court decisions directly, with only a few exceptions.

The author states that the book is intended as a hand book, not only for the patent specialist but for the general practitioner and the engineer not familiar with patent law as well. In many respects the book is well suited to this purpose, but in view of the extensity of the subject matter the author has been compelled frequently to lapse into terse and concise patent idiom quite meaningless to the outsider. Hence the book really presupposes some acquaintance with the subject. Numerous terms and expressions peculiar to patent law he defines from a philosophical standpoint, going back to prime fundamentals as it were, but he has wisely refrained from trying to define all of them.

The book is divided into ten major sections dealing respectively with a philosophical background, Right to Patent, Loss of Right (statutory bars and abandonment), "Inventivlevel" (a term coined by the author to define the measure of invention required for patentability), Right from Patent (territory covered, time of duration, rights against different entities), Scope of Protection (claims, their interpretation, statutory classes of invention), Patent Office and Practice (ex parte), Opposition, Correction, Revocation (covering disclaimers, reissues, interferences, etc.), Enforcement of Monopoly (both substantive and adjective law) and Ownership, Transfer, Contract (covering the various questions as to ownership, assignment, license, etc.).

The first section delves too deeply, it is thought, (and too much at random, also) in the philosophy of philosophy. The author might better have closed his statement, "The author does not know enough about philosophy to teach anybody . . ." with a period. He has, however, selected some very readable passages from prominent writers in an attempt to form a philosophical background for the more practical parts of the book.

After the introduction the author comes directly to the point in discussing the various topics indicated above. He sets down pertinent portions of the statutes, where desirable, defines his approach, and then proceeds to analyze them, phrase by phrase. Or, occasionally, he quotes from philosophers to approach the subject. Cross-references from one section to another are abundant —even superflous at times. He makes very frequent reference to his other works, but he is careful to distinguish statements of his private opinion from those based on adjudicated cases in the courts. His premise that much of patent law is a matter of "hunch," or "gut-reaction" as he terms it, is largely unfounded; these and other slang expressions seem out of place in a book of this character. Out of place also are his occasional jibes at the Nazi regime, the economic system, careless automobile drivers between Madison and Washington, the Supreme Court, and others of his pet peeves.

Aside from these faults, the book is a comprehensive treatise. It digests an enormous amount of material from authoritative sources, most of it being well-chosen. Its chief fault perhaps lies in its brevity—so much material has been gathered that adequate discussion is impossible in a single volume of this size. Necessarily the style is not literary—that could not be expected in a handbook summarizing the law sentence by sentence—but the expression is generally clear and distinct. The various topics are treated in sections—usually only a single paragraph closing with copious citations of authority. Most frequent are the citations from the U. S. Code Annotated, volume on Patents (West Publishing Co), Corpus Juris, Supreme Court Digest, Propriété Industrielle, Key citations from the Federal Digest, Decennial Digest, etc., and numerous articles published in this JOURNAL during the past eighteen years, and in other journals. As noted above, very frequent reference is made to other books by the same author, particularly to that excellent work which he prepared in 1934 in collaboration with our genial Mr Glascock, "Patent Examining and Soliciting." Other authorities are cited, such as Pollard's Digest, McCrady, Stoddard, Curtis, Walker, and Robinson. His references to the classic authorities last mentioned are rather infrequent and not always complimentary.

In parts the discussion is genuinely brilliant. In others it lapses into mere notes on decisions, digests, discussions or treatises, general and specific. Following the body of the text is a long bibliography listing all the authorities, except court decisions, cited in the text. It covers all the author's source material and ranges from general treatises on philosophy, logic, and cosmology to specific discussions of mechanical equivalents, setting interference motions for hearing, and other varied topics. Finally, and not of least importance, is the excellent and complete index covering nearly 100 pages. Better books may have been written on patent law but it is doubtful that a better index has ever been prepared. Other writers in this field could learn a great deal from Dr Stringham in the important technique of adequate indexing.

EDWIN M. THOMAS.

REVIEW FROM PATENT AND TRADE MARK REVIEW, Vol XXXV p 275

Dr Stringham describes his work as an exhaustive treatise on patent "law" in the narrow sense of "law." Nearly all patent decisions involve fact issues on which the decision is not a binding precedent, but at most a suggestion for future conflicts. The general lines to which this great mass of material points are indicated, and the digest sections showing further elaboration are cited.

Prepared for use in connection with United States practice, but utilizing the results of European research, the book is addressed to the engineer and general lawyer, as well as to the patent specialist.

Briefly, this well-know author of half a dozen important works on patents, being potentially a teacher, has written a book on patent law that is both interesting and "readable." Like his other works, moreover, the book is creative,—steeped in the subject and having definite ideas which he expresses without hesitation and in concise terms. there is no recourse to "padding."

The book reflects the individuality of its author, whose definitions and analyses are thought-provoking and often original. Certain allusions to extraneous matters, touches of irony and humor may be taken by some readers as inapt and lacking dignity; others will welcome these distractions as points of relaxation, the pauses necessary to any sustained effort, which humanize the book.

An advertisement mentions that the book includes the fruit of twenty years' research, of which five years were devoted exclusively to investigating patent law, copious citations of digests, books, and articles, and an elaborate, minute index,—the value of which will be appreciated through use.

The ten sections of this Outline treat respectively of Patent Law, Right to a Patent, Loss of Right, Inventivlevel (measure of invention), Right from Patent, Scope of Protection, Patent Office and Practice, Opposition-Revocation-Correction, Enforcement of Monopoly, Ownership-Transfer-Contract.

American Patent Law is thus outlined in its entirety, step by step, in one compact volume which is definitely an important addition to the subject.

PATENT CLAIMS

(TWO VOLUMES)

PAGES: 1392

SECTIONS: 526

DECISIONS: ABOUT 2600

DATE OF PUBLICATION: 1939 AND 1941

PRICE: $25.00

REVIEWS FROM PATENT AND TRADE MARK REVIEW, Vols XXXVIII and XL

Almost ten years ago Dr Stringham published "Patent Claim Drafting," the first book to treat claims separately and comprehensively. The contents of this earlier book of 339 pages have been stirred into a large quantity of additional material to make up the present work.

The Section headings for Volume I of the new and greatly enlarged work are: Claim drafting; Field of monopoly,—art, composition, machine, manufacture; Function and functionality; and Definiteness and accuracy; for Vol. II (not yet available) they will be: Words and other symbols; Style, quantity, and special problems; Robinson (1890) on claims; Ansprueche; Abbreviations; Bibliography; Table of cases; and Index,—the second volume dealing more particularly with language structure and being in effect a grammar of the patent claim.

The present Volume I includes a profusion of examples of actual claims sufficient to serve as models for guidance in drafting claims for various classes of inventions. The analytic and selective work accomplished by the author in making this "collection" of claims is in itself a formidable achievement.

Contradictory decisions, which are but too evident among those referred to, serve only to emphasize the importance of seeking, as has Dr Stringham, a logical and reasoned basis upon which to establish standards for reference. Definite knowledge as to how different courts have decided in concrete instances is of vital assistance in guarding against possible future holdings of invalidity, as for undue breadth of claims, inexact or ambiguous phrasing, etc.

Claim-drafting requires great concentration; to have available a work like the present, dedicated singly to the claim, wherein is searched out every angle in form, every subtlety of expression, with court decisions covering practically the gamut of possible pertinent questions, is indeed to have an extremely practical book aid.

Lacking Volume II, its index and table of cases, Volume I is nevertheless deeply interesting. This sincere effort to thoroly explore that measure of protection accorded the inventor, the patent claim, unquestionably merits the attention of all interest in patents.

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Dr Stringham has now completed the second volume of his two-volume work on Patent Claims which runs to 1,392 pages.

Vol. II section headings are: Words and other Symbols—including nonverbal symbols, accuracy, relative words, relative words illustrated, meaning, sources of meaning, particular words, words and things; Style, Quantity and Special Problems—including introductory expression, interpretation of introductory, words of exclusion, backfiring expression, quanity of claims, procedure as to quantity, combination and aggregation, and assembly and element. This is followed by an excerpt from Robinson (1890) on Patents (being Sections 504 to 538 relating to Claims); Ansprueche of German Patents (translations of about two hundred claims from German patents and from each of the main German classes); Abbreviations; Bibliography; Table of Cases; and Index—for both volumes.

Vol. II, in the words of the author himself constitutes a *grammar* for patent claim-drafting. It is certainly encyclopaedic in scope. The very thorough index now provided enables one quickly to locate many familiar words of claim language and the various court interpretations of their meanings. While the court definitions of a given word may be conflicting, they are indicative of its dependability or otherwise.

Dr Stringham, with his usual painstaking care and ingenuity, and his common sense attitude, considers every conceivable angle of claim-drafting,—styles or types of claims,—visualization, formalizm, tabulation; symbols,—from the structural formula of chemical claims to the French "resumé" type of the new plant patent claim; as well as punctuation. Under "Sources of Meaning," for instance, there are five subdivisions:—judge's knowledge; dictionaries; art or trade meaning; other patent; and specification. Office procedure in rejecting claims for specific reasons and the possibilities open to an applicant for reply are clearly set forth by reference to and excerpts from a group of pertinent decisions on each point. The Table of Cases covers about 100 pages.

These two volumes probably contain the answer of all questions of any importance relating to claims; no comparable work exists in the U. S. Whether for reference use or the study of patent law, this is a most exhaustive and interesting book on this highly technical subject. In spite of the technical nature of the work, however, Dr Stringham, in his own inimitable style, has produced not only a valuable reference for guidance when difficulties arise, but a book that can be read and enjoyed by veteran practitioner and student alike.

The foregoing is intended merely to convey some idea of the wide scope covered; the true value of the work will become apparent only through actual application to problems in hand. Anyone interested in claims or claim-drafting who is not already familiar with Vol. I, will surely now desire to inspect both volumes.

REVIEW OF VOL. I, ONLY, TEMPLE UNIVERSITY LAW QUARTERLY, Vol XIV p 560

As its title indicates, Dr Stringham's book is devoted entirely to patent claims and how they have been dealt with by the patent office and the courts. It is divided into five main chapters: Claim Drafting; The Art and Composition Fields of Monopoly; The Machine and Manufacture Fields of Monopoly; Function and Functionality; Definiteness and Accuracy. Volume II will contain two chapters: one on Words and Other Symbols; the other on Style, Quantity and Special Problems. It will also have an appendix containing excerpts pertaining to claims from Robinson on *Patents* as well as an index and table of cases missing in the first volume. To one familiar with patent law and interested in its problems regarding the wording of claims the above brief statement of subject matter needs no elaboration.

The book is entitled *A Drafter's Manual*. In one sense it is. It cites and quotes, often extensively, a vast number of cases involving disputes over claims: cases decided in the patent office and its appellate bodies, many of which are not easily accessible elsewhere, and cases in the higher and lower federal courts. The excerpts are freely interspersed with brief but valuable comments by the author. The material is well organized on the basis of terminology and subject matter. Thus, if one is looking for all the cases in which "means whereby"

claims were used, or all the cases where processes for treating fruits and nuts were involved, he will find them in specific sections, neatly collected and quoted. Some cases which the author deems especially important, for reasons that are not always apparent to one less familiar with the subject than he, are quoted in full. This approach has its advantages and disadvantages. The book is a guide book supreme for one who wishes to ascertain what forms of claims have been approved in the past in the fond belief that the same form is certain of approval in the future. It is a gold mine for one who is seeking already-mined nuggets with which he may dazzle this or that tribunal in an effort to direct it to or divert it from a sound decision.

If this were all that the book had to offer, it would probably not be worth writing, publishing or reviewing, despite the unusually good job the author has done. There are already enough books in the field explaining what the judges have said on a particular occasion with respect to a given situation. There are too many which provide us with gems that we tend to use indiscriminately without realizing that they lose their lustre and significance when removed from their settings. Fortunately, Dr Stringham has not confined himself to playing the collector and classifier. He stays on the train after most writers have docilely heeded the "everybody out" call. His excursions off the reservation are best described in the preface when he says that the book "may be compared to a fugue, in which the main 'subject' is that the scope of protection must be 'reasonable' and the counter-subject is that there are no statutory classes, but only one class, which could be designated 'art-machine-manufacture-composition'." In his tuneful manner he attacks the tendency toward arbitrary classification of patentable subject matter. He exposes the slavery of the tribunals to such question-begging terms as "function," "means" and "essential element," and points out the cloudy thinking and talking that such slavery engenders. He asserts that the real criterion by which a claim is to be tested for validity is that of reasonable breadth—an assertion that the believers in a mechanical jurisprudence will view with horror and alarm. Whether this last assertion is Dr Stringham's interpretation of how the judge actually works, consciously or subconsciously, or whether he is merely suggesting how the judge should work, is not entirely clear. Nor, perhaps, is it especially important which it is. What is important is the fact that the author confines himself only part of the time to the exercise of "mechanical skill." The rest of the time he disports himself in the higher realms of invention—and generic invention at that.[1] It is for this latter contribution that the book deserves the attention of students of the patent law, whether they be claim drafters and advocates on a busman's holiday or judges whose jobs require that they study law part of the time. It is also commended to the "jurisprudes"[2] whose interest in the law and its workings transcends such petty things as specific subject matters.

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[1]With all due respect to the author's insistence that improvement patenrs do not exist in the United Staes (p. 197) I suggest that there may be room for such here. Also one might suggest a "division" whereby the detailed ammunition for claim drafters and advocates would be separated from the material just described. The former might be held unpatentable as mere aggregation, but the latter would have the merit of enabling one to examine the invention clearly without having to wade through a morass of prior art.

[2]The term is Professor Llewellyn's.

REVIEW OF VOL. I, ONLY,
BOSTON UNIVERSITY LAW REVIEW
Vol XX p 596

The story of the genesis and the evolution of that characteristic feature of patents known as the "claim" constitutes a most interesting chapter in the history of patent law. No legislative edict ushered into being the patent "claim" as a formal constituent of patents, for long before the word "claim" appeared in statutory patent law (such first appearance occurring in the Patent Act of 1836), applicants for patents were appending to their disclosures paragraphs purporting to define their "inventions"—the prototypes of the present-day patent "claims."[1] These early "claims," like other innovations of the nonage of the U. S. patent system, some[2] destined, fortunately, to extinction, were fumbling efforts to fulfill a desired purpose; and most of them would, in these days, be rejected by the Patent Examiners as functional, indefinite, obscure and not defining "inventions." Yet, right up to the very eve of the passage of the Patent Act of 1836, many patents were issued without benefit of "claims"[3]: thereafter, the patent "claim" soon became the most important legal feature of patents.

What is (and has always been) the function of the patent "claim" is set forth in Section 4888 of the U. S. Revised Statutes in these mandatory words: ". . . he (the inventor) shall particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery." These very words occur in Section 26 of the Consolidated Patent Act of 1870, repealed and replaced by the present U. S. Revised Statutes of 1874, and they embody but a slight aleration of the wording of a portion of Section 6 of the Patent Act of 1836 (the legislation supplanted by the Consolidated Patent Act of 1870), wherein "specify and point out" stand in place of "point out and distinctly claim." Yet never, during the ninety-four years preceding 1930, did anyone attempt a detailed study of these legal entities. In that year, Dr Stringham issued his slim paper-backed booklet entitled "Patent Claim Drafting." In the preface to that booklet, Dr Stringham wrote: ". . . It seems unnecessary to say that, in a pioneer work of this character, much of what is put down must be regarded as tentative. . . . Judgment of the book is asked for upon the basis of what it includes, rather than upon the basis of what it omits. But criticism, both destructive and constructive, is invited." During the years subsequent, Dr Stringham has given the subject intensive study: errors and omissions in this booklet have been corrected and criticisms have been given careful consideration (characteristic of the author was his request for "criticism, both destructive and constructive," in precisely that order of preference); and the present volume, complete in itself but the first of a set of two volumes, will, with its companion volume when issued, become known as *The Anatomy of Patent Claims*.

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[1]E. g., the patent containing five long claims, granted on September 1, 1819 to Jethro Wood on a Plow, and the patent containing eight short claims, granted on February 25, 1836 to Samuel Colt on the Colt revolver.

[2]E. g., the single patent containing no claims, granted on May 21, 1811 to John H. Hall and William Thornton, sole inventors of two different but related inventions disclosed in the patent.

[3]E. g., the patent containing no claims, granted on July 1, 1836 to Washington Sweetser on a Trunk.

Omnipresently revealed in his writings are two characteristics of Dr Stringham's mind which I admire intensely—his eclecticism and his social consciousness. Now eclecticism is an especially desirable trait in a writer upon a subject such as patent law, wherein the wholly unlike techniques of the physical, chemical, biological and other sciences and the law coexist symbiotically. And in a writer treating of a branch of law so immediately reactive upon the economic structure of society as is patent law, social consciousness is a truly indispensable, if somewhat novel, intellectual asset. These mental characteristics are not the fruits of education in technology and law; they are immanent attributes of the exploring mind. In a literary style wholly devoid of the usual unsightly excrescences of legal phraseology, Dr Stringham displays his ideas, calling to his aid, for the attaining of the utmost clarity in exposition, particularly apt metaphors and similes borrowed from the seven arts and the more numerous sciences.

The book itself comprises five sections entitled: Claim drafting; Field of monopoly—art, composition; Field of monopoly—machine, manufacture; Function and functionality; Definiteness and accuracy; but I cannot be hopeful that this information will convey an adequate idea of its contents. And, if I say that, in this book, Dr Stringham has examined every decision of the courts wherein a patent claim has been in issue, I shall describe quite accurately its scope, but I shall not do, nor, in the space of this review, am I able to do, a modicum of justice to these results of a relentless and exhaustive probing that bares the strength and weakness of every decision examined. In this book, there is much plain speaking upon some of the clichés that are constantly employed in opinions of patent cases. One of these clichés is the ancient rule of patent law that "claims for the mere function of apparatus are not valid": writes Dr Stringham on this rule: "The author has never heard of any reason for denying such claims that seemed to him to deserve serious consideration. This statement is made without forgetting *Risdon* v *Medart*."[4] Any tribunal which must be omniscient in order to do its job at all will commit some terrible blunders. Every reader will have on the point of his tongue several decisions by the Supreme Court which, in historical perspective, can be seen to have been ghastly blunders. Within the relatively unimportant field of patent law, *Risdon* v *Medart* was such a blunder. . . . The opinion, by Justice Brown, has been finessed upon and glossed, by official and non-official writers. Candor demands recognition that this decision was a plain blunder." These repetitive "blunders" are hammer-blows that should start a few cracks in that venerable but absurd doctrine. Dr Stringham has kind words to say about the "functional claim"; and even when one does not agree with his views, one must concede that he advances able argument in their behalf. Dr Stringham's ideas upon claims pertaining to chemical inventions, and, more particularly, his ideas upon claims for chemical processes and upon implicit-process claims, are extremely perspicacious, and no better treatment of such claims exists elsewhere in the literature of patent law; my own view upon the validities of claims for true chemical compounds, as such,[5] are, of course, in complete disagreement with his views thereon. Finally, the entire section entitled "Definiteness and accuracy" is, in fact, an exposé of the jargon of patent law, and, by implication, a plea for less abuse of the English language.

CHARLES E. RUBY,
Member of the Boston Bar.

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[4] 158 U. S. 68 (1895).

[5] 89 Science 387 (1939).

DOUBLE PATENTING

PAGES: 624

SECTIONS: 112

DECISIONS: ABOUT 700

DATE OF PUBLICATION: 1933

PRICE, WITHOUT SUPPLEMENT: $7.00

In 1934 a supplement was issued, price one dollar. It is nearly out of print.

REVIEW FROM
GEORGETOWN LAW JOURNAL,
Vol XXII p 661

The author has, in seven chapters, treated a subject of prime importance to patent lawyers, patent attorneys, solicitors, and patent examiners, and one which is often wrongly interpreted to the detriment of property rights of clients.

Chapter I deals with the broad aspects of double patenting wherein: 1, Two patents inventively coextensive in the monopoly putatively covered cannot be validly obtained by the same inventor; 2, Of two patents to the same inventor inventively non-coextensive in monopoly putatively covered, the second will be invalid, if both patents disclose only the same single inventive embodiment; and 3, Of two patents to the same inventor patentably non-coextensive in monopoly putatively covered, the second will be invalid, if the invention it purports to protect was dedicated to the public by the first patent. The dangers of double patenting in instances where a common assignee owns a number of patents directed generally to the same invention have been skillfully treated by the author. The leading cases have been grouped to illustrate different aspects of double patenting under section headings in a manner convenient to a reader searching for authorities to fit a particular state of facts.

Chapter II on "Identic Monopoly" deals with various conditions which may arise in which two patents are for the identic monopoly if the respective claims are coextensive in the protection sought to be achieved.

Chapter III deals with "Different Statutory Class"; that is, whether the claims of two patents being considered under the doctrine of double patenting are for process and apparatus; process and product; composition-manufacture, and process; apparatus and product; and composition-manufacture and apparatus. The author points out that double patenting may occur in any of the statutory classes. The author holds that when process and apparatus claims are based upon a single inventive embodiment, there is no room for more than a single patent. Section 2828A of Chapter III, on the general survey of the relationship between design and utility patents, reprints in full the comment entitled: *Patents—Double Patenting—Design and Mechanical*, which originally appeared in the "Recent Decisions" columns of Volume XX, pp. 536-7 (May, 1932) of this Journal. It is to be regretted that Mr. Stringham erroneously gives credit to the GEORGETOWN LAW REVIEW instead of correctly to the GEORGETOWN LAW JOURNAL.

Chapter IV, on "Different Scope," treats cases in which claims of two patents differing in scope non-inventively are for the identic monopoly and are, accordingly, subject to the doctrine of double patenting.

Chapter V treats of sub-combination and overlapping elements in claims which often affect only the scope of the claims and may result in the application of the doctrine of double patenting.

Chapter VI is directed to "Reasons and the Twilight Zone," and sets forth examples of holdings of invalidity by the Court of Claims of patents in view of prior patents to the same inventor, and conversely, holdings where double patenting does not occur. The author treats the conditions arising in requirements for division and shows wherein a second patent may not be subject to invalidity on the ground of double patenting.

Chapter VII, entitled "Dedication, Abandonment, or Laches," points out that an invention disclosed but not claimed in a patent is dedicated to the public unless on the day of granting the patent, an application for it is pending

in the Patent Office. If an application is pending, no dedication arises unless the inventor is guilty of laches in presenting claims or in prosecuting his application.

The text contains a reprint of an article "Double Patenting" by Charles H. Shaffer of the Examining Corps of the Patent Office, originally read before the Examing Corps of the United States Patent Office in 1916. The article is well supported by reference to cases valuable as a reference work for practitioners. A paper presented before the Examining Corps of the Patent Office in 1917 by Arthur W. Cowles, of the Examining Corps of the Patent Office, entitled "A Phase of Double Patenting," is also reprinted as part of the text, and it contains a great deal of valuable information.

The author has prepared a comprehensive table of cases referred to in the text and has prepared a subject index which renders the book highly convenient as a reference manual.

The book will be found highly useful to the practitioner in litigation where attacks upon the validity of patents on the ground of double patenting are becoming increasingly numerous. The text is valuable to the student and solicitor in pointing out what is to be avoided in the drafting of claims not subject to attack on the ground of double patenting.

JOHN B. BRADY,
Members of the Bar,
District of Columbia.

REVIEW FROM JOURNAL OF THE PATENT OFFICE SOCIETY Vol XV

Dr Stringham is preparing piecemeal an elaborate, extended textbook on the patent law, and the present volume while covering a very small portion of the field, is a rather large meal. At first blush it would seem that it would be rather difficult to expand double patenting problems to over six hundred pages. A careful examination, however, of the present volume indicates that there is very little expansion and substantially no padding. The text is extremely meaty and covers double patenting from various aspects including some very closely allied matters. Many phases of the subject are taken up from the standpoint of court decisions and separately from the standpoint of Patent Office decisions and sometimes separately from the standpoint of decisions on appeals from the Patent Office to the Court of Appeals of the District of Columbia or the Court of Customs and Patent Appeals. In the course of this review of the decisions, the author points out what decisions are consistent with each other and what decisions are so inconsistent as to be almost contrary to the others. When the decisions are placed side by side this way it is rather surprising to see how much diversity of opinion there is with respect to almost all phases of double patenting. Indeed it is difficult to examine the book with any care without realizing that probably the most appropriate statement the author makes is "decisions both ways will be found." Because of this indefinite condition brought about by the reported cases, the author, with wisdom gathered from a careful reading of the cases and a mind saturated with the spirit of the patent law, delves into the legal and philosophical considerations which should underlie the various problems of double patenting. In substantially every instance the author states what he believes is the prevailing or the proper trend of the law together with the reasons for the faith that is in him. When the decisions seem not to support

what he believes is good law he does not hesitate to say, and endeavor to show, that the deciding tribunals have gone awry.

How the author overcomes some of his difficulties is indicated by:

> The foregoing statement may be unduly simple but it fits in with nearly every decision; even those which are not harmonious can probably be regarded as obsolete or erroneous.

Probably no lawyer would have the temerity to cite this to a judge in an effort to have overruled or disregarded an "obsolete or erroneous" decision.

Whether the tribunals in deciding cases in the future will look into Dr Stringham's arguments and conclusions and agree with him, so that a relatively definite reasoned law may come from the present chaos, may depend largely upon the extent to which the profession in dealing with double patenting problems refers to the present volume and leans heavily on it in preparing briefs to present to the various tribunals.

Because of the general difficulty of finding a logical approach to his subject the author devotes some time to definitions and a clear statement of the phases of the patent law he proposes to take up under the heading of double patenting. He has chapters on Identic Monopoly; Different Statutory Class; Different Scope; Subcombination and Overlapping Elements; Reasons and the Twlight Zone, and he ends with a chapter on Dedication, Abandonment, or Laches, which are subjects closely allied to double patenting and terms which are sometimes used interchangeably with double patenting.

About seventy pages of the appendix are devoted to the republication of articles of others dated 1905, 1916 and 1917. The propriety of preserving and printing such papers without thoroughly revising them and bringing them down to date may be questioned. It is clear, however, that the author thinks these articles important for the reasoning they contain rather than for their mere digesting of decisions.

While few members of the profession will care to read this volume page by page, it will be consistently referred to by everyone who has a double patenting problem to solve and the excellent index will help greatly in such use of the volume. The fact that the table of cases covers about 25 pages indicates that the author has probably covered substantially all of the decisions which are pertinent to his subject. Since Gourick's Digest is not generally available the author in a spirit of helpfulness has quoted in full many of the citations therefrom. A very helpful procedure has been adopted with respect to those decisions cited in volumes 1 and 2 of the United States Daily. Since those decisions have not been produced in permanent, easily accessible form in the United States Quarterly, which began with volume 3 of the Daily, the author gives the numbers of the patents involved so that the file wrappers may be examined to find the full text of the decisions. It is surprising to see how many cases cited were reported only in the United States Quarterly or in the United States Daily.

The author says:

> Near the middle of the twentieth century, when we ought to have learned to rise above this childish confidence in simplicity, a committee of the American Bar Association urged that Rule 41 be amended to provide that a process may be claimed in the same application with product and with apparatus. That a committee of lawyers in the year 1932, should hope to settle rigidly one of the insoluble problems is rather depressing.

Either he did not appreciate the underlying purpose of the Bar Association proposals or it slipped his mind for later he says:

> To the author it seems that normally no division requirement should be made as between process and apparatus; also that unless division has been required applicant ought not to be permitted to take two patents on one single inventive embodiment.

It is obvious that the danger of losing a right by double patenting may be largely avoided by allowing both process and product or apparatus to be included in a single application and in a single patent. In a recent decision the Board of Appeals has said "The grant of such claims in separate applications might conceivably give rise to a holding of double patenting" and it seems reasonable to avoid such difficulties by placing an inhibition against requirements for division as a practical matter as opposed to the ideal set up by the present author of requiring division only when it is appropriate although he "designates as 'absurd' the court cases which hold patents invalid." It is to avoid the difficulties inherent in "absurd" holdings that the Bar did make a general safety rule. The desirability of this seems to be emphasized by the author himself when he intimates that he may not have told the whole story:

> The dichotomous method which has been followed in earlier chapters is believed to have been a perfectly sound approach to all questions of law we have been investigating. It did not ignore the existence of border line instances, but it is assumed that these were to be decided in other rubrics of patent law, and that for purpose of double patenting questions, we could assume that all claims are sheep or goats.

Certainly no one can use this volume to any extent without appreciating that the profession as a whole owes a deep debt of gratitude to Dr Stringham of his intensive labors.

K. F.

REVIEW FROM JOURNAL OF THE PATENT OFFICE SOCIETY Vol XV

NOTE:—This book has been reviewed by Mr Fenning in the November number of the JOURNAL, but the present review has been written without consideration of the earlier contribution.

The average Examiner has crystallized his knowledge of double-patenting after studying recent decisions into a very few precepts, if not a single one. If the two applications involved were copending and present different patentable embodiments upon which the specific claims are respectively predicated, it matters not which application was first filed and to which the broad claims are confined. From this single expression and its corollaries may be deduced most of the items of practice that are relied upon by the Examiner when this question is confronted. Yet Dr Stringham has written a volume on double-patenting of about 600 pages of compacted material the bulk of which is germane to this subject-matter. In order to know how this can be done, it is necessary to peruse his book, for no previous discussion or treatise of this character remotely suggests the scope of the field, wealth of material and abundance of decisions that Dr Stringham has been able to discover or utilize.

At the outset, Dr Stringham takes care to define his terms and to coin a few of his own to better distinguish and classify certain specific aspects that have apparently been ambiguously and confusedly expressed hitherto. Such for example are "identic monopoly," "identic inventive embodiment" and "co-extensive in monopoly." The terms which Stringham finds objectionably used

are "same invention," "embraced" or "covered," which may or may not be applicable if strictly interpreted. A specific invention, as Stringham properly declares, may be validly granted although "embraced" or "covered" by a dominating claim of a prior generic patent. But a later patent addressed to the "identic monopoly," i. e., "coextensive in monopoly," which necessarily embodies question of scope, is bad for double-patenting. To illustrate Stringham's terminology and treatment, the following summary is quoted from his book.

[Items 1, 2, and 3, quoted herein near the top of page 18, are again quoted.]

The high point of the book is the emphatic opinion that a gap in Office prosecution abandons in every instance the unclaimed disclosure of the prior patent. This is contradicted in *Mullen and Mullen,* which still governs the Office practice. But according to the evidence from court decisions cited *ad lib* by Stringham, a second patent so granted will be of no avail in court procedure. Another point noted is the risk an assignee of an application takes on the question of anticipation, as well as, comparable with an applicant, on the question of double-patenting. This double liabity does not apply to the applicant, as anticipation *per se* can not be involved in the cases considered. This peculiarity of the practice while necessarily deducible from the decisions is not featured as such in the book.

The question of "dominance and subordination of patents" is considered at great length. As Stringham says "One of the simplest, clearest, soundest, and most essential principles of patent law, is that a later invention may be validly patented, although dominated by an earlier patent, whether to the same or to a different inventor. No one will seriously deny the correctness of this statement in principle. But it is incessantly lost sight of when an actual case must be decided." Further quoting from *Cantrell v Wallick* (U S p 694) is the passage "Two patents may be valid when the second is an improvement on the first, in which event, if the second includes the first, neither of the two patentees can lawfully use the invention of the other without the others consent." It is though that much of this discussion could be abbreviated by a reference to the article on "The 'Exclusive Right' to an Invention," this JOURNAL Vol. VIII, p. 255, where the philosophy of the doctrine is logically and historically developed in short compass.

Extremely valuable to the practitioner is the extended treatment of apparatus, process and product inventions; utility and design patents; and patents for combinations and sub-combinations with relation to "identic monopoly" and other aspects of double-patenting.

In spite of the highly technical nature of the subject and the concentration required in studying this treatment, there is much that is interesting reading. Many digressions in the fields of logic, biology and particularly economics are offered for the edification of the reader. In the disputed fields of sociology and economics, positive conclusions are developed. It must be comforting to reach a clear determination on social questions that have involved most others in mists of doubt. The mental ease that justifies confidence in one's own opinions is indicated in the ready application thereof to the legal questions considered. These digressions, however, add value to the treatise by their stimulating effect upon the student. Incidentally, the vocabulary abounds in words rare to the less erudite reader, some requiring resort to the dictionary, and others of new coinage not yet gathered in lexicons. As a source book on its special subject and as an analytical contribution, it is a master-piece.

W. I. W.

PATENT INTERFERENCE EQUITY SUITS; AND SUPPLEMENT

PAGES: 213
SECTIONS: 75
DECISIONS: ABOUT 400
DATE OF PUBLICATION: 1930 WITH SUPPLEMENT 1934
PRICE, WITH SUPPLEMENT: $6.00

REVIEW FROM
JOURNAL OF THE PATENT OFFICE SOCIETY,
Vol XII

The present volume is one section of a treatise in which the author hopes to treat the whole body of patent law. It treats of actions under 4915 and 4918 R. S. Interest in such actions is increasing rapidly because of the change in procedure established by the recent revisions of the Act relating to appeals from the Patent Office. The new trade mark law when it is enacted will have additional action somewhat analogous to 4915 and 4918. Thus the present volume is timely. It is especially helpful since there has been no previous elaborate treatment of the subject.

The text is divided into about 100 sections, the logical arrangement of which is indicated by the table of contents. There is a full and sufficient index and in the table of cases there is said to be all decisions relating to procedure under the two sections of the statute. There is a good bibliography and elaborate forms covering over fifty pages of the book. The text itself is condensed into a little over 100 pages.

To some, the form of the book will seem undesirable. Each section begins with a statement in bold type followed by an alphabetical list of cases and then the text, sometimes of a few lines and sometimes of a few pages. In the text the cases are not cited in full. Sometimes they are referred to by the name of the plaintiff and sometimes by the name of the defendant and sometimes by both names. This is a novelty in legal text arrangement and may take some time for the user to become acclimated. Just what is the advantage in the arrangement does not appear. It does, however, seem to lend itself possibly to needless repetition and difficulty of reference.

The treatment of the matter is sketchy in some respects because of the theory on which the book is prepared. Suits under 4915 and 4918 are like other equity suits and their form, practice and procedure is controlled very largely by the Judicial Code and the Equity Rules. The author frankly admits this and and makes no effort to write a book on equity procedure. When, however, a specific point of practice or procedure has been specifically treated by a court in a 4915 or a 4918 suit, the author gives the matter attention. The result is naturally apparently out of balance altho it is the exact thing the equity lawyer wants. It gives him freedom to follow general equity procedure unless the courts have already determined the particular point in which he is interested must have some specific unusual treatment in 4915 or 4918.

Likewise in order to make the review of the cases more or less complete some unusual matters slip in. The author, however, has refrained from mentioning the interpretation of the treaty involved in *Robertson* v *General Electric,* 32 F(2d) 495.

The profession is much indebted to the author for having collected the matter and for having elucidated some obscure points. Certainly no one should attempt to go into a 4915 or 4918 case without having this volume at hand.

The style may be gleaned from the following quotations: "To expect human tribunals to hold industry for infringement of what is clearly shown to be old, is probably chimerical." "In this treatise suits between patentees are treated first, because they are perhaps a trifle simpler and, at all events, there have been fewer of them reported." "Infringement claims may be joined in an interference patents suit, but by the weight of authority an infringement claim

may be prosecuted even tho an outstanding question of priority is not expressly pleaded." "Neither courts nor commentators have remarked upon the fact that a suit between interfering patents, if joined with no other cause, is purely a suit for a declaratory judgment." "The service of process in suit by an applicant is the same as in suit by a patentee, as covered in section 7932 hereof. One decision happens to have been made in an application suit and is covered here."

K. F.

REVIEW FROM CORNELL LAW QUARTERLY, Vol XVI p 629

In an introductory note, the author, himself an examiner in the Patent Office, indicates a purpose to gradually develop a series of treatises designed to include the whole body of patent law, a task expected to consume a number of years. He has set up a proposed division of subjects which would be included in such a development and assigned distinguishing numbers to the various subjects to be treated. Thus the series will present a succession of main and sub-ordinate sections by which the user of the series will have at hand a brief statement of the law governing the various subjects which he may need to consider in connection with a service as practitioner in patent law whether before the Patent Office or the courts, as well as an aid to the jurist who may be called upon to consider patent matters. The series will thus become of service more particularly to those specializing in patent law. The plan of the series, however, is one which lends itself to the treatment of individual subjects without especial regard to a development in regular order, and for this reason the author has apparently selected subjects initially which are of particular interest to the profession because of new phases, etc. This is indicated in the present treatise, the subject of which he has assigned to the 7900 series in the general treatment. The treatise is the second of the series and others are in course of preparation.

The author deals with questions of interference, as where rival inventors are attempting to monopolize an invention, and considers the subject on the basis of the activities outside of the Patent Office. Specifically, he is dealing with questions which arise under the provisions of Sections 4918 and 4915 of the Revised Statutes, the former bearing more particularly upon cases involving interfering patents, the latter relating to conditions where one or more applications for patents are involved. The latter subject is especially important to the practitioner at present because of the changes which have resulted from the modification of section 4915 in 1927, by which it has become possible for an interference proceeding, after decision in the Patent Office, to be taken into the courts under certain conditions, and receive consideration there as an equity proceeding. Previously, it had been necessary to appeal to the Court of Appeals of the District of Columbia before the statutory provision could be invoked. The modification of the statute eliminates this particular appeal. Such an appeal can still be taken to the Court of Customs and Patent Appeals—now the appellate tribunal of the Patent Office—but when taken, the statute closes the door to equity action in the courts. The statute thus sets up alternative courses, which can be taken selectively, for review of the decisions rendered by Patent Office officials. Such alternative courses are also open to *ex parte* cases, but the present treatise considers only those relating to interference proceedings. And, likewise, the treatise does not consider the questions involved where

the appeal is taken to the Court of Customs and Patent Appeals, since the jurisdiction of that court is limited to its particular relation to the Patent Office, in patent cases. Because of the change in the statute, the practice and law bearing on this phase of the subject are developing more rapidly, and the author's timely discussion has made it possible to gather a general view of the law as it has so far developed, and thus provides an aid to the practitioner in this direction.

The treatise itself indicates that the author has done much research work in seeking and studying the various decisions which have been announced. A particular phase of the subject forms the basis of a succession of subordinate sections, each of which carries a citation to the particular decisions which apply thereto. In the succeeding text of the section, the author has presented his comments on a particular decision and its application to the subject, permitting the reader to cull out those decisions of less interest to him without actually reading them. A time index—a statement as to when action must be taken—is included, as are both a subject index and a table of cases. A few representative forms are also provided.

The work is one designed for practitioners who may be called upon to handle cases of this type, as well as the jurist. It is so arranged as to be of material service in such cases, since it gives the substative law that has developed under both sections of the statutes up to the time of its preparation in 1930.

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Washington, D. C.

SEMIOTIC OF PATENT INTERFERENCE COUNT

PAGES: 198
SECTIONS: 62
DECISIONS: ABOUT 350
DATE OF PUBLICATION: 1941
PRICE: $5.00

When the present booklet goes to press there has not yet appeared any review of this little treatise on interpretation of the interferences count, except a rather stereotyped review in *Journal of Patent Office Society* for 1941 May.

PRELIMINARY STATEMENT IN PATENT INTERFERENCE

PAGES: 141
SECTIONS: 52
DECISIONS: ABOUT 250
DATE OF PUBLICATION: 1938
PRICE: $4.00

REVIEW FROM
BOSTON UNIVERSITY LAW REVIEW
Vol XIX p 507

"An interference is a proceeding instituted (by and within the U. S. Patent Office) for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention. . . ." Thus reads a portion of Rule 93 of the U. S. Patent Office Rules of Practice defining the most important form of *inter-partes* proceedings conducted by and within the U. S. Patent Office. Now the Preliminary Statement in an Interference corresponds to the initial pleadings in a general law case, and this volume constitutes an exhaustive treatment of this particular form of pleadings. Thus, Chapter 1 comprises an account of the nature and purposes of the Preliminary Statement; Chapter 2 deals with the specific averments required therein and their forms and meanings; Chapter 3 describes the procedure employed in the use of the Preliminary Statement in an Interference; Chapter 4 explains the operation and effects of the preliminary Statement; and Chapter 5 defines the metes and bounds of permissive amendment of the Preliminary Statement after it is filed in the U. S. Patent Office. Following these five chapters of text, various forms of Preliminary Statements, a table of the cited cases, and a typical Stringham index conclude the volume.

This volume, like all other of Dr Stringham's writings, is a significant contribution to the literature of patent law, but it is, alas, but a fragment of a planned exhaustive treatment of all phases of the subject of Interferences, the composition of which has had to be abandoned "because of the faintness of the prospect of enough effective demand to justify completion of the undertaking." In my reviews[1] of two of Dr Stringham's earlier works, I have expressed forthrightly my admiration of his writings, for he possesses the ability to render fascinating the dullest of subject matters; and by the extraordinarily high quality of the present work, in itself complete, I am convinced that the literature of patent law would be definitely the richer, could the planned work, of which this little volume constitutes but a small portion, be added thereto.

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REVIEW FROM
GEORGETOWN LAW JOURNAL
Vol XXVII p 516

There are a good many people in the world doing a good many things and it is not surprising that frequently a plurality of people do the same thing at about the same time. It is well known that in the medical profession there is some doubt as to who originated anaesthetics. The invention of the first Bell telephone patent was claimed to have been made by other inventors than Bell. Very early in its existence, the Patent Office set up procedure for determining who is the first inventor when an invention is claimed by two or more parties.

The patent laws of most foreign countries make no provision for priority of invention contests. The patent generally is awarded to the first who applies

[1] 16 Boston University Law Review 519; 17 Boston University Law Review 769.

for it. In the United States, however, by statute the only one entitled to a patent is the first inventor. It is necessary, therefore, to determine who is the first inventor, when more than one is before the Patent Office at the same time. The technical term applied to proceedings to determine priority of invention is, "interference." When it is found that more than one persons is before the Patent Office with respect to the same invention, an interference is declared and entered into. The application papers on file for the various parties in the Patent Office, are of importance and may be relied on, but the parties in their proofs may go beyond these papers.

The first thing which is done in an interference, is to call on the parties to file a paper which is analogous to a pleading. Each party is called on to file a so-called, preliminary statement. This is a statement in which each party sets up under oath the earliest dates he will claim for drawings, model, and other details of the reduction and development of the invention. The content of preliminary statements has been varied somewhat from time to time but the parties are always strictly limited to proving the dates set up in their preliminary statements. Neither party can obtain the benefit of any date earlier than the date set up in his preliminary statement. It is clear, therefore, that the preliminary statement is a very important paper and must be carefully, thoughtfully, and intelligently prepared. It is not unusual to ask for permission to amend a preliminary statement. These amendments are grudgingly granted; yet frequently refused entirely. In a way, this seems a harsh procedure, because after the interference proceedings in the Patent Office have terminated, a party may go into a federal court and file an equity suit to determine priority of invention, and in that equity suit he may set up and prove whatever dates he can, irrespective of the dates he may have alleged in his preliminary statement. Naturally, such variations in dates are frowned upon by the courts. The preparation of the preliminary statement for the Patent Office remains, therefore, a very important pleading and its importance is increased with the value and importance of the invention involved. It is not surprising, therefore, to find that the present author is able to fill a fair sized book with the law relating entirely to the pleading which is of interest to those dealing with that very small corner of patent law. The attention given to the matter by the tribunals of the Patent Office and by the courts is indicated by the fact that the table of cases in this book covers twelve pages.

The author, at one time, was in the Patent Office and in the Interference Division which has specifically to do with preliminary statements. He has had considerable experience in examining the law and stating it in various texts. This is the sixth book he has published in eight years. It is not surprising, therefore, to find that the present volume is a helpful, thoroly workmanlike job. It will be found substantially essential to the patent lawyer who is going into an interference proceeding.

Some idea of the interesting style of the author may be gained from his explanation of judicial discretion:

"Decision on motion to amend preliminary statement is not an arithmetic task. Taking various factors into consideration, the tribunal exercises a hunch or discretion. The lack of objective standards is designated in *Pratt* v *Thompson* as acting equitably."

The author points out what he conceives to be the distinction between a brief and a text book:

"The practitioner cannot present matters in the crude blunt style of the preceding paragraph. He must improvize imaginary differentiations between precedents and his present case, hinting delicately at the central point. The text book writer, if he does a decent job, must be more forthright."

The way of an inventor involved in an interference in the Patent Office may be eased if he and his attorney carefully examine this book before filing their initial preliminary statement.

KARL FENNING.*

REVIEW FROM PATENT AND TRADE MARK REVIEW Vol XXXVII p 20

As indicated by its title, this work deals exclusively with a special and very important subject—The Preliminary Statement, which of course constitutes the very basis of an interference proceeding in U. S. Patent practice and corresponds somewhat to the pleadings in court cases. Dr Stringham mentions that his book is a fragment of a proposed work already prepared on interference procedure and evidence; it strikes the writer as a very convenient unitary addition to the patent library.

The work has five divisions entitled respectively, Preliminary Statement—definitive and historical—; Averments; Procedure; Operation and Effect; and Amendment by Motion, to the delicate questions of which latter approximately seventy pages are devoted.

It is believed that this book will be found of great practical value due largely perhaps to its very clear (bold-type), terse and definite section headings which, with Dr Stringham's customary meticulous index, *make available* practically all the essential knowledge and rulings on this special subject as reflected by the cited cases with pertinent quotations therefrom.

When the matter of preparing and filing, or amending a preliminary statement arises, consultation of the present authoritative treatise will undoubtedly enable the patent lawyer to decide with a new facility any questions presented by the particular case.

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PATENTS AND GEBRAUCHSMUSTER IN INTERNATIONAL LAW

PAGES: 638
DECISIONS: FEW
DATE OF PUBLICATION: 1935
PRICE: $7.00

REVIEW FROM
IOWA LAW REVIEW
Vol XXII p 780

Dr Stringham's apparent purpose in this late book is, in general, rather more cultural than utilitarian as in the case of his previous works on interference suits (1930), double patenting (1933), and patent soliciting and examining (1934). It therefore fills a different place for the professional reader than has been generally accorded the other exhaustive and scholarly treatises of this author. The book, however, well repays careful reading, which should give the fresh viewpoints and broadened background that inhere in such an adequate comparative study of the highly developed patent laws of various nations. So ambitious an undertaking is unusually well done in 447 pages of text, with a bibliography of over 250 items and a thorough index.

Dr Stringham's name appears as editor because three of the six chapters are the work of foreign authorities. The introduction is a translation, with notations, of an article by Lainel of which it is said "Written by a Frenchman about the German office it provides the Englishman or American with a good picture of patent systems."

The first chapter, which is preceded by the text of the Paris convention as amended, is a history of the development of international relations in patent matters, and some of the accomplishments, omissions and failures of the various Congresses and conventions are there surveyed.

The second chapter is a highly interesting comparison of the patent laws and practice of Germany, England and the United States wherein the social and economic considerations leading to some differences in these respective systems are suggested. It is written by A. du Bois-Raymond of Berlin, who attempts to discriminate between difficulties, such as waste effort, which may be inevitable as a part of the natural law governing technical progress, and other difficulties which seem to result from defects in the patent laws themselves. Critics of the patent systems are themselves criticized for failure so to distinguish. Comparison of many topics in the patent law of each of these three countries is made. Such topics include the examination system, methods of determining patentability, legal effect of patents, interferences, publication, taxes and workings, and, in conclusion, a statement of various defects is given.

Chapter 3 is a more detailed and annotated discussion of the German patent law and procedure by Dr Albert Osterrieth of Berlin. Here again comparison with the laws of England and the United States is made.

Chapters 4 and 5 are devoted to Gebrauchsmuster. The operation of these short term patents for minor inventions, which do not exist in the United States, is not widely appreciated and this complete exposition of this subject will greatly aid in a needed dissemination of knowledge and suggestion concerning it, and may well lead to the adoption of a similar device here.

The last chapter relates mainly to international priority rights, but also includes such miscellaneous subjects as bilateral trade treaties, importation of patented articles, fees and taxes, compulsory license and working, and the law of the principal countries of Europe, Canada and the United States as it affects aliens.

The book will be read with profit by those interested in the patent system and its development amid the current social and economic trends in the United States today.

JOHN B. CUNNINGHAM,
Member of the New York City Bar.

REVIEW FROM
WEST VIRGINIA LAW QUARTERLY
Vol XLII p 273

If one were seeking a good focal point from which he could quickly survey the temper of the prevailing economic order, he need only peer briefly into the machinations of patent law structure. He will perceive a rapid succession of scenes on the national and international stage, starting with the trade expansion period of the Industrial Revolution, and shifting temporarily through the Congresses of Vienna, Paris and Madrid to the more recent Washington and Hague Conferences. The well-trained observer need not be tangled in the net of these passing events, however. Permeating the desire for national and international patent monopolies with their huge financial accoutrements is the constant pattern of a simple ideal which stands out in bold relief,—the ideal of private property with the "right to exclude others."

The same focal point will also reveal the weakness inherent in the "international" slant upon society. Just as the League of Nations has crumpled under the pressure of autonomous groups, so in the field of patents no effective international legislative body has emerged from all of the conventions. The international patent has yet to be born, and because of the persistence of national values, the chances for birth are remote. The only "rights" and "privileges" that have transcended the national arena have been brought about mostly by bilateral, and sometimes multilateral treaties. For this reason it is difficult to understand the meaning of the term *international* in Mr Emerson Stringham's edition of *Patents and Gebrauchsmuster in International Law*. The study is at best a collation of *national* patent laws, together with a resumé of the international patent agreements to date.

Aside from one chapter entitled "Soviet View," which has been placed in an awkward context, the study is devoid of interpretive insight. Instead of expanding the social implications manifest in this chapter, the remainder of the articles of Du Bois-Raymond, Osterrieth and Isay, plus the editor's contributions merely describe the technical ramifications of the English, French, German, Italian, Russian, Canadian and American systems. This may be valuable for one who seeks only to enrich his store of factual knowledge in the field of comparative law. One, for instance, may learn what to pour into the vague receptacle called "patentability"; the nature of Gebrauchsmuster or short-term patent; the powers of administrative tribunals in patent procedure; the rapid advancement along design registry lines; the methods of contesting a patent; the necessity for "compulsory working"; the research methodology; the nature of annulment procedure and the remedies available to those who assert their patent rights. But one does not glean a clear picture of the balance between the interests of inventor, competitor and society. It is not shown clearly, for instance, that France favors the inventor, that Germany favors the industrialist, and that in England the societal aspect is impressed, with patent monopoly regarded with disfavor. Such generalizations one must distill from a poorly organized mass of data.

There too is lacking a critique of the prevailing patent theory. In examining the detail of the various systems, one cannot avoid being impressed with the fact that the legal forms lag far behind the present-day needs. For instance, there is no reward offered to those who discover the "principles" upon which the practical "applications" are based. Patent pools, monopolistic "cross licenses," the formation of price cartels, are all evils which partly arise out of our

patent structure, and, despite the Sherman and Clayton Acts, still remain—unperturbed. Finally, most inventors are under strong economic compulsion to assign their mental products to powerful industrialists who "benevolently" subsidize them. Once, inventors were offered patent protection in exchange for the benefit that they may confer upon society. Today, their efforts seem to be canalized into improving previously patented processes—a practice which inevitably results in greater "exploitation" through monopolization.

JULIUS COHEN,
West Virginia University,
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REVIEW FROM SOUTHERN CALIFORNIA LAW REVIEW, Vol XII p 105

This volume is a collection of material relating to patents and utility models, the latter being usually referred to in the United States as "petty patents" but which in Germany are technically designated "Gebrauchsmuster." The "Gebrauchsmuster" has no parallel in the United States patent system. In this work Dr Stringham functions much more as a translating editor than as an author.

Unfortunately, the book was published just before promulgation of the new law on Gebrauchsmuster, which was passed in Germany simultaneously with the patent law of May 5, 1936, and therefore it is not quite up-to-date on the subject.

The general purpose and object of the work is not at first readily apparent, inasmuch as the introduction, which is a close translation of an article published in 1927 by Mr George Lainel in L'Industrie Chemique, is neither directed to, nor explanatory of the volume, but concerns the German Patent Office.

Chapter I is a history of The International Union and contains much interesting information gathered from many, and not readily accessible, sources. It contains an overabundance of detail of somewhat dubious value to a practising attorney.

Chapter II is a comparison of the patent laws and procedure in Germany, England and the United States by A. duBois-Reymond of Berlin but with part of which the author-editor takes violent exception and characterizes as being "so hopelessly illogical that they [arguments] crumble as they are read." This material was originally published in 1912; has been edited and revised to bring it up-to-date as of 1934 and is interspersed with comments by the author.

Chapter III is a discussion of the German patent law and patent procedure by Professor Dr Albert Osterrieth. This material also originally was published in 1912 and has been revised, deleted and criticized by the author and brought up-to-date as of 1934.

Chapters II and III are in the main authoritative and of unquestionable value.

Chapter IV entitled "Gebrauchsmuster" was assembled by the author but is lacking in logical presentation of the subject; contains many references to other sources not readily available, which should be consulted in order fully to develop the points in question and as a whole is rather unsatisfactory. However, it does contain a translation of the German "Gebrauchsmuster" statute and rules of practice as of 1934.

Chapter V also is entitled "Gebrauchsmuster" and is a monograph written by Dr Hermann Isay, regarding which the author-editor says:

"Translated from ISAY (1932 pp 598-657). Citations of authorities and cross references have mostly been omitted; anyone having an actual problem will wish to locate these authorities and examine them; the present translation gives a very complete background and a guide to any necessary detailed study."

Chapter VI, entitled "International Patent Law" and the final chapter in the book, has little or no relation to the subject of Gebrauchsmuster but contains selections and digests from the laws and literature of Germany, U. S. S. R., France, Italy, England, Canada and the United States, which are intended to supplement the material heretofore published on the subject.

While this collection of monographs will probably be of very little use to the practising patent lawyer, nevertheless, the volume should be very useful to those who are interested in following international affairs which deal with the protection of industrial property. The work clearly indicates Dr Stringham's thorough familiarity with the law and procedure relating to German patents and utility models.

WM. EDWARD HANN,
Los Angeles, California.

REVIEW FROM HARVARD LAW REVIEW, Vol XLIX p 1022

This volume brings together material on patents and utility models; the latter, commonly referred to in this country as "petty patents," originated in Germany where they are known as *"Gebrauchsmuster."* Part of the work is new, while the major portion consists of material already published in English or in French and German, and revised or brought up to date by Mr Stringham. The remainder bears upon German patent and utility model law and procedure, of which Mr Stringham has been a student of many years' standing and with which he has a very thoro and quite exceptional familiarity.

Except for a few corrective notes, the introduction is a close translation of an article published in 1927 by Mr George Lainel in *L'Industrie Chemique.* It concerns the German Patent Office. Chapters II and III are essays by the German patent lawyers, A. du Bois-Reymond and Albert Osterrieth, which were originally published in 1912 and have been revised by the editor so that they are accurate as of 1934. The first is a comparative study of the patent law and procedure in Germany, England, and the United States; the second, a discussion of the German patent law and patent procedure. Chapter V is a translation from Professor Hermann Isay's treatise on the patent and utility model law* dealing with utility models in Germany. They are all three authoritative studies, and Mr Stringham has done a real service in bringing them up to date and publishing them in his volume.

The other three chapters (which are the author's own work) deal with the history of the international union for the protection of industrial property, with utility models, and with international patent law. For the history of the union, the author has gone to many sources and gives, somewhat unnecessarily, an abundance of details. This is followed by a discussion of various matters covered by the international convention. The author's brief defense of industrial designs and models as a separate branch of industrial property is not very convincing. The chapter on *Gebrauchsmuster* gives information on the countries which have legislated upon these petty patents of short duration for small invention. It contains the text and English translation of the German law and rules of practice, a brief discussion of these, and pertinent German literature. The last chapter on international patent law is invaluable in giving selections and digests on patent law in Germany, U. S. S. R., France, Italy, England, Canada, and the United States. It is too bad Japan is omitted. This chapter demonstrates the author's erudition and familiarity with foreign sources.

STEPHEN P. LADAS,
Author of The International
Protection of Industrial Property (1930).

*Patentgesetz und Gesetz betreffend den Schutz von Gebrauchsmustern (6th ed. 1932).